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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,911	12/30/2003	Peter S. Avritch	559292000100	1389
22434	7590	07/03/2007		
BEYER WEAVER LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			EXAMINER KANE, CORDELIA P	
			ART UNIT 2132	PAPER NUMBER
			MAIL DATE 07/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,911

Applicant(s)

AVRITCH ET AL.

Examiner

Cordelia Kane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/14/04 7/28/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the non-provisional application filed on December 30, 2003. Claims 1 – 49 are pending. Claim 1 is independent.

Claim Objections

2. Claim 47 is objected to because of the following informalities: applicant references at the receivers side processing a request from the receiver. It appears this should reference processing a request at the service since the service provides the requested information. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 11 recites the limitation "the step of generating the digital signature" in claim 1. There is insufficient antecedent basis for this limitation in the claim.
5. Claims 1 – 49 are rejected because claims 1, 4, 21, 22, and 27 use the phrase "nominally" which renders the claims indefinite because the claims do not properly define the association.
6. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. It is unclear what is meant by a "link to advertising information relative to the sender".

Double Patenting

7. Claims 3, 8, 21, and 39 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 11, 9, 22, and 41 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 4, 8 – 19, 21 – 24, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by David Montville's US Patent 6,356,937 B1. Referring to claim 1, Montville teaches:

a. Providing a service request comprising information about the email message (column 23, lines 53-58).

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- b. Processing a portion of the request to determine a result, providing the result to the senders side, incorporating the result in the email message and transmitting the email message (column 16, lines 14-27). The processing the portion of the request is evidence by encryption and digital signing of the message which is then sent.
 - c. Receiving an email message that is a result incorporated email message, and processing the email to assess the integrity of it (column 16, lines 43-54). The processing the email message is evidence by the decrypting and digital signature verification.
10. Referring to claim 2, Montville teaches:
- d. The step of processing the request includes generating a digital signature, and the result includes a digital signature (column 16, line 21).
 - e. The step of processing the received email message includes processing the digital signature (column 16, line 54).
11. Referring to claim 3, Montville teaches:
- f. The digital signature includes performing public/private key encryption (column 8, lines 37-39).
 - g. Processing the digital signature includes decrypting using public private key decryption (column 16, line 54).
12. Referring to claim 4, Montville teaches:
- h. Determining whether it is a result incorporated email message (column 16, lines 53-55).

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- i. If it is not a result-incorporated email message, performing a first particular action (column 24, lines 48-50). The particular action being downloading and viewing the message.
13. Referring to claim 8, Montville teaches:
- j. The result includes an indication of a level of certification (column 16, line 21, and column 7, lines 32-33).
 - k. The integrity is assessed in view of the indication of the level of certification (column 16, line 54).
14. Referring to claim 9, Montville teaches:
- l. The result includes an indication of a level of certification (column 16, line 21, and column 7, lines 32-33).
 - m. The integrity is assessed in view of the indication of the level of certification (column 16, line 54).
15. Referring to claim 10, Montville teaches filtering the email message based on the determined level of certification (column 21, lines 15-19).
16. Referring to claim 11, Montville teaches:
- n. The digital signature includes performing public/private key encryption (column 8, lines 37-39).
 - o. Processing the digital signature includes decrypting using public private key decryption (column 16, line 54).
17. Referring to claim 12, Montville teaches:

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- p. The request includes sender verification information (column 16, lines 6-9).
 - q. The processing of the verification information is inherent from the log-in and password steps. It would be inherent that the password would be verified before any further steps were taken.
18. Referring to claim 13, Montville teaches that the request includes a digest of the message body (column 8, lines 17-18).
19. Referring to claim 14, Montville teaches that the request does not include the message body or information from which the message body can be derived (column 8, lines 17-21).
20. Referring to claim 15, Montville teaches the digest is generated using a SHA algorithm (column 8, lines 29-31).
21. Referring to claim 16, Montville teaches deriving the portion of the request from which the result was determined, and then processing the portion of the request and the email message (column 16, lines 53-54). This deriving and processing is the decryption process that is performed.
22. Referring to claim 17, Montville teaches:
- r. Deriving the portion of the request includes using a decryption algorithm (column 16, lines 53-54).
 - s. Generating a digest of the message body and processing that digest (column 7, lines 17-18).

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23. Referring to claim 18, Montville teaches that the decryption algorithm includes using a public/private key decryption (column 8, lines 37-39).

24. Referring to claim 19, Montville teaches that the result is incorporated into the message by including it in the header (column 16, lines 43-47). The content of the message is included in the header which would inherently include the result.

25. Referring to claim 21, Montville teaches that the sender is nominally associated with the senders side and that a physical location is associated with the sender (column 11, lines 6-10). The use of a driver's license or passport to prove the senders credentials means that the physically location of the sender would be inherent.

26. Referring to claim 22, Montville teaches that the sender is nominally associated with the senders side and how to locate the sender at a later date (column 11, lines 6-10). The use of a driver's license or passport to prove the senders credentials means that the address of the sender would be included and therefor finding them at a later date would be inherent.

27. Referring to claim 23, Montville teaches associating a degree of certainty with the determination (column 11, lines 1-6).

28. Referring to claim 24, Montville teaches that the result includes an indication of the degree of certainty (column 7, lines 32-33). Since the certificate level is included in the email it is inherent.

29. Referring to claim 35, Montville teaches that the request includes indication of the email address of the sender, and receiver and is encrypted (column 16, lines 14-27).

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Montville also teaches that the request includes a digest of the message body (column 8, lines 17-18).

30. Referring to claim 36, Montville teaches that processing the received result to assess integrity is without interacting with the service (column 26, lines 56-66).

31. Referring to claim 37, Montville teaches:

t. Encrypting the result with a private key (column 8, lines 22-23)

u. It is inherent that the decryption that occurs would use the public key since it's public key cryptography being used (column 8, line 13) and if the private key was used for encryption then the public key would be used for decryption.

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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34. Claims 5 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville and further in view of Jack Zoken's US Patent 5,944,787. Montville discloses all the limitations of the parent claim. Montville does not appear to explicitly disclose performing a particular action based on the assessment of the integrity of the message. However, Zoken discloses:

- v. Organizing an email inbox based on the integrity assessment (column 3, lines 30-35). The organization of the inbox is inherent from the fact that the email is filtered and isolated from other emails. (claim 5 and 7)
- w. Displaying an indication of the outcome of assessing the integrity (column 3, lines 36-39). The outcome is displayed by listing the results generated from the databases accessed.

35. Montville and Zoken are analogous art because they are from the same field of endeavor, email verification. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Zoken before him or her, to modify Montville to include performing an action based on the integrity assessment of Zoken. The motivation for doing so would have been to treat similarly certified documents the same. Therefor it would have been obvious to combine Zoken with Montville to obtain the invention as specified in the instant claims.

36. Claim 20 is rejected under 35 USC 103 (a) as being obvious over Montville in view of Wayne Baldwin et al's US Patent 5,877,757. Montville discloses all the

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limitations of the parent claim. Montville does not appear to explicitly disclose that the message is formatted according to SMTP. However, Baldwin discloses SMTP is a well known in the art of networking (column 6, lines 42-45). Montville and Baldwin are analogous art because they are from the same field of endeavor, networks. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Baldwin before him or her, to modify the email and header of Montville to include SMTP of Baldwin. The motivation for doing so would have been that SMTP is well known in the art (column 6, lines 42-45) and therefor the email can be processed by the majority of email clients. Therefor it would have been obvious to combine Baldwin with Montville to obtain the invention as specified in the claim 20.

37. Claims 25, 26 and 31 – 34 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Paul McKeon's US Patent 5,926,552. Montville discloses all the limitations of the parent claim, as well as that the user is a subscriber (column 3, line 10). Montville does not appear to explicitly disclose how the subscriber joins the service. However, McKeon discloses:

- x. The subscriber agreeing to terms of service (column 6, line 15). (claim 25)
- y. Signing and agreeing to terms of service inherently creates the initial subscription to the service. (claim 26)

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z. The sender requesting to subscribe to the service then sending an inquiry message to the send via mail, then observing how the sender handles the inquiry message (column 6, lines 7-16). (claim 31, 32, and 33).

aa. A signature is required (column 6, lines 23-26). The signature is inherent by the fact there is a contract.

38. Montville and McKeon are analogous art because they are from the same field of endeavor, certifying a subscriber. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and McKeon before him or her, to modify Montville to include the terms of service of McKeon. The motivation for doing so would have been it makes the certification process more secure (McKeon, column 1, lines 62-64). Therefor it would have been obvious to combine McKeon with Montville to obtain the invention as specified in the instant claims.

39. Claims 27 – 30 and 44 – 46 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Jeffrey Heiner's US Patent 6,112,227. Montville discloses all the limitations of the parent claim as well as the user having a plurality of email addresses (column 14, line 16) . Montville does not appear to explicitly disclose using an inquiry message with the sender, and filtering emails based on a collective characteristic. However, Heiner discloses:

bb. Sending an inquiry message to the email address and observing the behavior of the sender (column 3, lines 46-48). (claim 27)

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cc. Sending a reply message back to the service (column 3, lines 47-48).

(claim 28)

dd. Including in the inquiry message a set of instructions (column 3, lines 59-60). (claim 29)

ee. The instructions include a link to a particular URL or web page (column 4, lines 4-5). (claim 30)

ff. Determining a collective characteristic, not registering, of the plurality of emails (column 4, lines 26-31). (claim 44)

gg. Performing a particular action in not providing the result, otherwise known as not delivering the email (column 4, lines 34-35). (claims 45 and 46)

40. Montville and Heiner are analogous art because they are from same field of endeavor, email certification. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Heiner before him or her, to modify Montville to include the inquiry messages and filtering of Heiner. The motivation for doing so would have been that junk mail is a known problem for users (column 1, lines 11-12) and this is an effective way to prevent unwanted emails (column 1, lines 57-60). Therefore it would have been obvious to combine Heiner with Montville to obtain the invention as specified in the instant claims.

41. Claims 38 – 43 are rejected under 35 USC 103 (a) as being obvious over Montville in view of William Castell et al's US Publication 2002/0132607 A1. Montville discloses all the limitations of the parent claim. Montville does not appear to explicitly

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disclose generating a second result determining if it was generated as a result of a virus, and then performing a particular action. However, Castell discloses:

- hh. Generating a secondary result (page 3, paragraph 35). (claim 38)
- ii. Providing an indication of the secondary result (pages 3-4, paragraph 39).
The indication of the secondary result includes determining to not forward the email on. (claim 38)
- jj. Performing a particular action based on the secondary result (pages 3-4, paragraph 39). (claim 39, 41)
- kk. The email message was generated as the result of a virus (page 3, paragraph 33). The problem is viruses, so it is inherent that viruses is what the filter is looking for. (claim 40)
- ll. Not sending the message (page 3-4, paragraph 39). While it does not specifically say how it is not sent, when combined with the method of Montville not sending it would mean that no other certification of any kind occurred including not determining the result and not providing the result to the sender. (claim 42, 43)

42. Montville and Castell are analogous art because they are from the same field of endeavor, protecting emails. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Castell before him or her, to modify the sending methods of Montville to include the virus screening of Castell. The motivation for doing so would have been that it prevents flooding the

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network (Castell, page 3, paragraph 33). Therefore it would have been obvious to combine Castell with Montville to obtain the invention as specified in the instant claims.

43. Claims 47 – 49 are rejected under 35 USC 103 (a) as being obvious over Montville in view of Andre Morkel's US Publication 2002/0052921 A1. Montville discloses all the limitations of the parent claim. Montville does not appear to explicitly disclose providing contact information of the sender to the receiver. However, Morkel discloses:

mm. Processing a request from the receiver to obtain contact information and then providing that contact information (page 1, paragraph 8). (claim 47)

nn. It would be inherent that the email would be in a format appropriate for the client so that the requestor would be able to read the contact information. (claim 48)

oo. A link to advertising information relative to the client (pages 3-4, paragraph 39). (claim 49)

44. Montville and Morkel are analogous art because they are from the same field of endeavor, processing emails. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Montville and Morkel before him or her, to modify Montville to include the providing contact information of Morkel. The motivation for doing so would have been that peoples contact information changes frequently (Morkel, page 1, paragraph 3) and that contact information methods often

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lack security features to prevent unwanted access (Morkel, page 1, paragraph 5).

Therefor it would have been obvious to combine Morkel with Montville to obtain the invention as specified in the instant claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cordelia Kane whose telephone number is 571-272-7771. The examiner can normally be reached on Monday - Thursday 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CPK


JOSEPH DEL SOLE
SUPERVISORY PATENT EXAMINER

6/27/07